

REMARKS**Drawings**

In the previous amendment, Applicant submitted a proposed drawing change. The Examiner approved the proposed drawing change and has required the submission of substitute drawings according to the proposed change. Office Action, page 2. Accordingly, Applicant has submitted, concurrently with this amendment, substitute drawings and a separate letter to the draftsperson requesting the substitution of the drawings in lieu of the original drawings.

Rejection under 35 U.S.C. § 103(a)

Claims 1, 5-8, 11-15, and 18-20 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,940,049 to Hinnman et al. (hereinafter Hinnman).

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art cited must teach or suggest all the claim limitations. *See M.P.E.P. § 2143.* Applicant respectfully asserts that the rejection does not satisfy these criteria.

Claim 1 is directed to a system for providing an overhead image, that includes:

a central processing unit (CPU) to process said digital information before receipt by said video subsystem, wherein said CPU is operable to determine a background color of said document and is operable to replace said background color with a replacement color to optimize visual contrast between text in said document and said replacement color.

Claim 8 is directed to a method for providing an overhead image, that includes:

processing said digital image representation to enhance readability of said digital image representation for overhead projection, wherein said processing comprises determining a background color of said document and replacing said background color with a replacement color to optimize visual contrast between text in said document and said replacement color; and

driving a video subsystem with said processed digital image representation to project said overhead image.

Claim 14 is directed to a system for providing an overhead image projection that includes:

means for digitally enhancing said digital information to enhance readability of an overhead image, wherein said means for digitally enhancing is operable to determine a background color of said document and is operable to replace said background color with a replacement color to optimize visual contrast between text in said document and said replacement color; and

a video subsystem operable to project said overhead image utilizing said enhanced digital information.

In the outstanding rejection, the Examiner acknowledged that Hinnman does not teach or suggest determining a background color of said document and replacing said background color with a replacement color to optimize visual contrast between text in said document and said replacement color. Office Action, page 3. To address this lack of teaching or suggestion, the Examiner stated that Hinnman discloses a projection device that includes "a digital FIR image sharpening filter." Col. 2, lines 37-40. Hinnman specifically discloses that the digital finite impulse response (FIR) filter is adapted to correct lens aberrations. *Id.* The Examiner further asserted that the FIR filter could "presumably" modify other errors. Office Action, page 3. However, it is well-settled that the "mere fact" that a reference could be combined or modified "does not render the resultant combination obvious." M.P.E.P. § 2143.01, citing *In re Mills*, 16 USPQ2d 1430 (Fed. Cir. 1990). Thus, because the requisite motivation to modify Hinnman has not been provided, Applicant respectfully submits that a *prima facie* case of obviousness has not been established for claims 1, 5-8, 11-15, and 18-20.

The Examiner further asserted that the "presumed" ability of the digital FIR filter includes the ability to change the color range/background color, increase contrast, and/or perform edge enhancements, because these operations are known to be performed by "graphics related applications." Office Action, page 3. In the previous amendment, Applicant traversed the assertion that the claimed subject matter was known in the prior art and requested the Examiner to identify references to support the Examiner's proposition. The Examiner introduced U.S. Patent No. 6,198,845 to Tse et al. (hereinafter Tse) to support the proposition that it was known in the art to change "the color range/background color" of an image. Office Action, page 4.

However, the disclosure of Tse does not teach or suggest the claimed subject matter. Namely, Tse does not at least teach or suggest replacing a background color with a

replacement color to optimize visual contrast between text in said document and said replacement color. Instead, Tse merely discloses gray-level processing of an image. Col. 1, lines 51-53. Specifically, because the image of Tse is a gray-level image, there can be no modification or processing of the chromatic components of the image. Thus, there is no replacement of a background color with another color of a different chromatic content. Moreover, Tse discloses estimating the gray-level of the background utilizing a histogram implemented algorithm. Col. 1, line 64 - col. 2, line 23. After the gray-level of the background is determined, the dynamic range of the entire image is adjusted by mapping the gray-levels of the image to zero through the "whitest white" of the system. Col. 2, lines 39-50. Because Tse processes the gray-levels of the entire image, Tse does not teach or suggest specifically processing the background to optimize visual contrast between text in said document and said replacement color.

The other reference made of record in the rejection by the Examiner (U.S. Patent No. 4,992,955) is not asserted, by the Examiner, to teach or suggest and does not teach or suggest determining a background color and replacing "said background color with a replacement color to optimize visual contrast between text in said document and said replacement color."

Accordingly, Applicant respectfully submits that the prior art does not teach or suggest each and every limitation of claims 1, 8, and 14. Claims 5-7, 11-13, 15, and 18-20 respectively depend from base claims 1, 8, and 14 and, hence, inherit all limitations of their respective base claim. Therefore, a *prima facie* case of obviousness has not been established for claims 1, 5-8, 11-15, and 18-20.

Conclusion

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 08-2025, under Order No. 10008276-1 from which the undersigned is authorized to draw.

I hereby certify that this correspondence is being deposited with the U.S. Postal Service as Express Mail, Airbill No. EV259594857US, in an envelope addressed to: Box AF, Commissioner for Patents, Washington, DC 20231, on the date shown below.

Date of Deposit: January 29, 2003

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Respectfully submitted,

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